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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,752	10/30/2003	Lawrence D. Bergman	YOR920030395US1	8753

7590 09/05/2008  
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Locust Valley, NY 11560

EXAMINER
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DAO, THUY CHAN

ART UNIT	PAPER NUMBER
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2192

MAIL DATE	DELIVERY MODE
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09/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,752	<b>Applicant(s)</b> BERGMAN ET AL.	
	<b>Examiner</b> Thuy Dao	<b>Art Unit</b> 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 29-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application<br>6) <input type="checkbox"/> Other: _____. |
|---|---|

### DETAILED ACTION

1. This action is responsive to the amendment filed on May 20, 2008.
2. Claims 29-36 have been examined.

### Response to Amendments

3. In the instant amendment, claims 29 and 36 have been amended.
4. The 35 USC §101 rejection over claim 36 is withdrawn in view of Applicant's amendments.

### Response to Arguments

5. Applicants' arguments have been considered. However, they are not persuasive.

The Applicants asserted,

"Nonetheless, Applicants have amended independent claims 29 and 36, incorporating the preamble in to the claim limitations. The claims now recite, customizing the control of the user-interface of the existing application by installing a user-interface control relating to the procedure description in the existing application for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated. Wolfman does not disclose customizing the control of the user-interface of the existing application as discussed above. For at least these reasons, Wolfman fails to anticipate independent claims 29 and 36" (Remarks, page 5, second paragraph, emphasis added).

The examiner respectfully disagrees. Wolfman explicitly teaches:

*a user-interface of an existing application* (col.5, FIG. 2, user-interface of an existing application SMARTedit; col.4, section 2 "Case Study: SMARTedit" and related text);

*a control of the user-interface of the existing application* (e.g., col.5, FIG. 2, SMARTedit user-interface includes 4 buttons and one panel);

*record a procedure description comprising a series of actions* (e.g., col.4: 29-34; col.4: 47- col.5: 26; col.12:56 - col.13: 6)

*performed by a user in the application user-interface* (e.g., col.4:28 - col.5: 27; FIG. 2 at col.5); and

*customizing the control of the user-interface of the existing application* (e.g., col.12, FIG. 4, the customized control of SMARTedit user-interface now includes three new buttons and new Interaction Control Panel, wherein each interaction has its score and is represented by the darkness of its fonts and the bar gauges based on said score, col.12: 12-38)

*by installing a user-interface control relating to the procedure description in the existing application* (e.g., col.13: 22-37; FIG. 4, col.12:12 - col.13: 6).

Accordingly, the examiner respectfully maintains the 35 USC §102(b) rejection over claims 29-36 in view of Wolfman.

### **Claim Rejections - 35 USC §102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfman (art of record, "Mixed Initiative Interfaces for Learning Tasks: SMARTedit Talks Back").

#### **Claim 29:**

Wolfman discloses an article for manufacture and an apparatus for customizing a control of a user-interface of an existing application comprising:

*a memory; and at least one processor (e.g., col.3:42 - col.4: 28), coupled to the memory operative to:*

*a user-interface of an existing application (col.5, FIG. 2, user-interface of an existing application SMARTedit; col.4, section 2 "Case Study: SMARTedit" and related text);*

*a control of the user-interface of the existing application (e.g., col.5, FIG. 2, SMARTedit user-interface includes 4 buttons and one panel);*

*(i) record a procedure description comprising a series of actions (e.g., col.4: 29-34; col.4: 47- col.5: 26; col.12:56 - col.13: 6)*

*performed by a user in the application user-interface (e.g., col.4:28 - col.5: 27; FIG. 2 at col.5); and*

*(ii) customizing the control of the user-interface of the existing application (e.g., col.12, FIG. 4, the customized control of SMARTedit user-interface now includes three new buttons and new Interaction Control Panel, wherein each interaction has its score and is represented by the darkness of its fonts and the bar gauges based on said score, col.12: 12-38)*

*by installing a user-interface control relating to the procedure description in the existing application (e.g., col.13: 22-37; FIG. 4, col.12:12 - col.13: 6)*

*for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated (e.g., col.13: 7-27; col.1: 1-28; col.4: 59 - col.5: 26).*

**Claim 30:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by a user in the application user-interface comprises the steps of.*" *transmitting at least one request for application user-interface structure information from a procedure capturer to an operating system (e.g., col.7:40 - col.8 ;30); and receiving the application user-interface structure information from the operating system at the procedure capturer (e.g., FIG.4, col.12:38 - col.13:21 ).*

**Claim 31:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by the user in the application user-interface comprises the step of registering the procedure capturer with the operating system to receive notification of user actions and system actions* (e.g., col.5: 27-54).

**Claim 32:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by the user in the application user-interface comprises the steps of: receiving notification of user action within the application interface at the procedure capturer; determining a result activated by user action at the procedure capturer; mapping the activated control into a generic description at the procedure capturer* (e.g., FIG. 2, col.4:59 - col.5: 54); *adding the generic description to a procedure representation at the procedure capturer; determining if there are more user actions; and storing the procedure representation in the procedure capturer if there are no more user actions* (e.g., FIG. 4, col.11: 3 - col.12: 35).

**Claim 33:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of installing the control relating to the procedure description in the existing application comprises the steps of." sending a request to an operating system from a control installer to install the control* (e.g., col.6:37 - col.7: 7); *creating and installing the control in the application user-interface through the operating system; and registering a callback at the operating system using a location supplied by the control installer* (e.g., col.13:22 - col.14: 14).

**Claim 34:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the at least one processor is further operative to execute an installed control* (e.g., col.13:6-21 ).

**Claim 35:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of installing the user- interface control comprises the step of altering the appearance of at least one existing user interface control* (e.g., FIG. 4, col.12:38 - col.13: 5).

**Claim 36:**

Claim 36 is an article of manufacture version, which recites the same limitations as those of claim 29, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the reference teaches all of the limitations of the above claim, it also teaches all of the limitations of claim 36.

**Conclusion**

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/  
Examiner, Art Unit 2192

/Tuan Q. Dam/  
Supervisory Patent Examiner, Art Unit 2192